

REMARKS

Applicants respectfully request consideration of the subject application. This Response is submitted in response to the Office Action mailed February 23, 2006. Claims 1-52 stand rejected. In this Amendment, claim 1 has been amended. No new matter has been added.

35 U.S.C. § 112 Rejections

The Examiner has rejected claims 1-49 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 has been amended to remove the limitation "the value." Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-49 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-26, 28-31, 50, 51, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi (U.S. Patent No. 6,086,066, hereinafter "Takeuchi") in view of Inoue (U.S. Patent No. 5,395,111, hereinafter "Inoue"). The Examiner has rejected claims 19, 27, 32, and 33-49 under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi in view of Inoue and further in view of Bennett (U.S. Patent No. 6,089,977, hereinafter "Bennett").

Applicants respectfully submit the cited art fails to teach or suggest, inter alia, as claimed in claim 1: "wherein the first image component and second image component are displayed on the same electronic display, the characteristics of a basic game image over which the second image component is superimposed is changed by the game control means such that the result of a game played on the console is changed in at least some plays of the game by the second image component." Applicants respectfully submit the cited fails to teach or suggest, inter alia, as claimed in claim 50: "a game controller configured to (a) control the display to, for a play of the gaming device, display base game symbols defining on outcome for the play and (b) alter the display and outcome for a play by controlling the display to display a superimposed, transparent second image, said second image and any underlying game symbols visible to the player." Similar limitations are included in independent claims 51 and 52.

The Examiner submits that "interpretation/indication of the basic game, first images and superimposing second images in terms of method/rules/values for playing are not indicative of any furtherance to the game apparatus." The Examiner further submits that "images and image combinations "indicating" feature game/poker/special prize/condition/service messages are interpretations of outcomes and do not limit the game any further." Applicants respectfully disagree.

Claim 1 includes the following limitation: "wherein the first image component and second image component are displayed on the same electronic

display, the characteristics of a basic game image over which the second image component is superimposed is changed by the game control means such that the result of a game played on the console is changed in at least some plays of the game by the second image component.” Thus, claim 1 requires a game control means that causes superimposing second images over first images on the electronic display means, as presently claimed. Providing a game control means which provides this feature is clearly a furtherance to the game apparatus. Similarly, claims 50-52 each include a game controller which superimposes images, as presently claimed. Clearly, a game controller which superimposes images, as presently claimed, is a furtherance to the game apparatus.

The second image component of Takeuchi simply does not have any effect on the basic game played on the Takeuchi machine. The machine first determines whether a jackpot result has been achieved, and if so, the second image component is actuated to cover one of the symbols comprising the winning array of symbols in order to emphasize that a winning jackpot was achieved.

The second image component, thereby, provides an enhanced visual celebration of the win, but does not in any way alter the outcome of the game that was played prior to the appearance of the second image component.

In Takeuchi, the second image component is only provided to “sufficiently enhance the player’s impression when winning a jackpot, thus allowing enjoyability to improve.” See, for example, col. 4, lines 38-39 of Takeuchi.

Inoue does not in any way make up for the deficiency of Takeuchi. Inoue quite clearly relates to another form of gaming machine altogether: one in which reel symbols are combined in order to achieve a winning result. Clearly, the two reels shown in Inoue could be side by side, with the side by side reels combining to achieve a particular symbol result. In effect, Inoue teaches an arrangement in which two reels together combine to achieve winning outcomes.

Neither Takeuchi, Inoue, nor the combination thereof, provides any teaching or suggestion as to how the outer transparent reel could somehow be unconstrained. Indeed, quite clearly since Inoue teaches physical reels, it would not be possible to arrange for the symbols on the outer reel to somehow randomly move around the display to cover other symbol positions, as presently claimed.

Likewise, Bennett provides no assistance at arriving at the presently claimed invention. First, Bennett does not teach transparent symbols. Bennett merely teaches symbols that substitute or other symbols in the display.

More importantly, Bennett does not teach or suggest the random movement of the transparent second symbol over the display. Indeed, Bennett teaches symbols that move in a rigid, predefined path to substitute for all of the

symbols in the display. For example, at col. 3, line 35 – col. 4, line 50, Bennett provides that the “Penguin” feature has a start position at the top left hand symbol of reel 1, and a finish position at the bottom right hand symbol of reel 5.

Clearly, Bennett does not disclose a randomly moving symbol that “overlies” the other symbols. Rather, the symbols of Bennett change in an ordered sequence. It will be appreciated that symbol changes in gaming machines are well known in the art.

Thus, the cited art fails to teach or suggest the invention as presently claimed in independent claims 1 and 50-52. Claims 2-49 depend, directly or indirectly, from claim 1 and are therefore patentable for at least the same reasons.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-26, 28-31, 50, 51, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi in view of Inoue, and claims 19, 27, 32, and 33-49 under 35 U.S.C. § 103(a) as being unpatentable over Takeuchi in view of Inoue and further in view of Bennett.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen De Klerk at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested

is hereby requested. Please charge any corresponding fee to Deposit Account
No. 02-2666.

Respectfully submitted,

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